

REMARKS

Claims 1-30 are pending. Applicants elect with traverse to prosecute the claims of Group V, encompassing claims 1-5, 10 and 19, drawn to a method of improving lung function using inhibitors of TGF β -R1 kinase.

Traversal of the Restriction Requirement

“If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions.” 35 U.S.C. § 121. The M.P.E.P. explains that a restriction requirement is only proper when claimed inventions are shown to be independent or distinct and that there is a serious burden on the examiner if restriction is not required. M.P.E.P. § 803. The M.P.E.P. further explains that the examiner has the burden to establish a *prima facie* case that a restriction requirement is proper. *Id.* The present Action fails to meet this burden.

The Office has divided the claims into eight (8) different groups. However, each group is classified in class 424, subclass 94.5 and groups I-VII are all drawn to a method of improving lung function using an inhibitor of TGF β -R1 kinase. Group VIII is drawn to a method of treatment of a subject having lung disease, encompassing claims 22-30, which also require the use of an inhibitor of TGF β -R1 kinase. Each group delineated by the Office appears to read on the same general invention. The Office has done nothing to state specifically why these groups constitute unrelated inventions beyond stating that they allegedly have different modes of operation, different functions, or different effects. All groups improve lung function using an inhibitor of TGF β -R1 kinase. Thus, each has the same mode of operation, the same function, and the same effect. Moreover, given that each group resides in the same class and subclass, the Office has failed to demonstrate that a serious burden will be placed upon the examiner to search all the claims as a single invention.

In view of these deficiencies, the reasons offered in support of the present restriction requirement do not provide a *prima facie*. As such, the restriction requirement should be withdrawn or restated with greater particularity.

The Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 219002034100. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: April 10, 2006

Respectfully submitted,

By 

James J. Mullen III, Ph.D.

Registration No.: 44,957

MORRISON & FOERSTER LLP

12531 High Bluff Drive

Suite 100

San Diego, California 92130-2040

(858) 720-7940